



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,246	01/15/2002	Bradley M. Andreae	720-00023	3917
26753	7590	08/12/2004	EXAMINER MAYEKAR, KISHOR	
ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/053,246	ANDREAE ET AL.	
	Examiner	Art Unit	
	Kishor Mayekar	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of invention of Group I, claims 1-17 in the reply filed on 25 June 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitations "comprising passing ... and subsequently curing the deposited paint" and "comprising: moving the containers ... and causing said containers ... paint" are confusing as whether all the recited steps are claimed, the

Art Unit: 1753

first two or the latter two. Also, there is an inconstancy in the recitation of the limitation "container" as at the beginning it is recited in singular and later in plural.

The phrase "the paint coating section" lacks antecedent basis.

In claim 2, "the heat curing section" lacks antecedent basis.

In claim 15, the phrase "can be" needs to be replaced with --is-- to eliminate reference to not positively recite the claimed process.

In claim 16, the same is applied to claim 15.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPITZ (5,810,987) in view of either SAKAI (4,812,211) or URQUHART (5,562,810). OPITZ's invention is directed to a process for efficiently

electrophoretically coating small items. OPITZ discloses in Fig. 1 all the steps as claimed. OPITZ further discloses in the abstract and col. 4, lines 46-50 that the process comprises the steps of changing the position of small parts during the coating and baking and in col. 4, lines 26-34 and col. 2, lines 36-55 the use of an electrically conductive swivel container. The difference between OPITZ and the above claims is the provision of a conveyor unit for mounting the container. SAKAI shows in a process for electrodepositing coating small items the provision of container mounted in a conveyor unit (see abstract and Figs. 1, 4 and 7). URQUHART shows in an electrodeposition line the provision of container mounted on a conveyor unit (see Figs. 1 and 11 and abstract). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified OPITZ's teachings as shown by URQHAR because the provision of mechanical means or automatic means to replace manual activity has been held to be obvious, *In re Venner* 120 USPQ 192.

As to the subject matter of claim 12, to the use of UV lamps in the curing section, the selection of any of known equivalent heating devices would have been within the level of ordinary skill in the art.

6. Claims 7, 8 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPITZ '987 as modified by KSAKAI '211 or URQUHART '810 as applied to claims 1-6 and 9-11 above, and further in view of BRENT et al. (5,385,655). The difference between the references as applied above and the instant claims are the type of parts and paints. BRENT shows the above limitations in a method of electrodepositing coating on metal parts (col. 2, lines 58-68; col. 5, line 65 through col. 8, line 61). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the references' teachings as shown by BRENT because the selection of any of known equivalent metal parts and paints would have been within the level of ordinary skill in the art.

#### *Oath/Declaration*

7. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not have the signature of the first three inventors.

***Information Disclosure Statement***

8. The information disclosure statement filed May 28, 2002 is not considered because the written statement is not a prior art. It would be better if Applicant to resubmit the statement in the form of a declaration.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

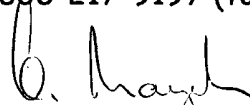
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

Application/Control Number: 10/053,246

Page 7

Art Unit: 1753

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "K. Mayekar", is positioned above the printed name.

Kishor Mayekar  
Primary Examiner  
Art Unit 1753